REMARKS

Currently pending claims 1-21 are for consideration by the Examiner.

The Examiner rejected claims 1, 3, 6-7, 9, 12-13, 15, 18, 19 and 21 under 35 U.S.C. §103(a) as being unpatentable over Luchs et al. (herein Luchs; USPN 4831526-filing date 4/22/1986) in view of Hoyt et al. (herein Hoyt; USPN 6067531-filing date 7/21/1998) and in further view of Shirley et al. (herein Shirley; USPN 5692206-filing date 11/30/1994).

The Examiner rejected claims 2, 8, and 14 under 35 U.S.C. §103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).

The Examiner rejected claims 4-5, 10-11, 16-17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of Grubb et al. (herein Grubb; USPN 5272623-filing date 11/7/1990).

Applicants respectfully traverse the §103 rejections with the following arguments.

35 U.S.C. §103

The Examiner rejected claims 1, 3, 6-7, 9, 12-13, 15, 18, 19 and 21 under 35 U.S.C. §103(a) as being unpatentable over Luchs et al. (herein Luchs; USPN 4831526-filing date 4/22/1986) in view of Hoyt et al. (herein Hoyt; USPN 6067531-filing date 7/21/1998) and in further view of Shirley et al. (herein Shirley; USPN 5692206-filing date 11/30/1994.

Applicants respectfully contend that claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley.

As a first example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest "one or more model agreements". The Examiner alleges: "Luchs teaches the use of common application forms (col 2, ln 26-61; compare with '*one or more model agreements*;')".

In response, Applicants note that Luchs recites in col. 4, lines 3-19: "This contract is substantially simplified over existing insurance contracts and is created to be custom tailored for the particular client and risk involved.... Thss custom tailoring is achieved by a compiling and editing function in the central processor in which data representing predetermined form paragraphs are stored, and those paragraphs which are applicable to the particular insurance contract requested are selected. ...These separate and complete paragraphs are then sequenced by the processor for printing in the desired order to yield an insurance contract which is tailored to the client and the risk" (emphasis added). To apply the preceding teaching to claims 1, 7, and 13,

note that an agreement is a contract (see any dictionary). Applicants respectfully contend that Luchs's system does not include model agreements (i.e., model contracts) as required by claims 1, 7, and 13, but instead includes a database of stored paragraphs, such that an insurance agreement (i.e., insurance contract) may be formed from the selection of particular paragraphs from the database of paragraphs.

In further illustration of the first example, consider the following analogy. First, consider a room ("Room A") that stores computer parts (microprocessors, hard drives, power supplies, monitors, etc) such that computers may be synthesized from a selection of computer parts from Room A. Next, consider another room ("Room B") that stores model computers. By application to claims 1, 7, and 13, Shirley teaches Room A which stores paragraphs from which agreements (i.e., contracts) may be synthesized after a selection of paragraphs from Room A. In contrast, claims 1, 7, and 13 teach Room B which stores the model agreements themselves.

As a second example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: "a document assembler for selecting and merging all or part of said one or more model agreements into a contract in response to said client request" (claim 1); "assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool" (claim 7); and "third program instruction means for assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool" (claim 13). As explained *supra*, Luchs selects and merges individual paragraphs to form an insurance contract, while claims 1, 7, and 13 recite

selection and merging of model agreements to form a contract.

As a third example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest "a repository for storing said contract and said tracking data and for responding to said client inquiry" (claim 1); "storing said contract and said tracking data in a repository" (claim 7); and "fifth program instruction means for storing said contract and said tracking data in a repository" (claim 13). The Examiner alleges: "Luchs also discloses storing the contract and associated data in a repository (col 4, ln 28-31; compare with *"a repository... inquiry. "*)."

In response, Applicants respectfully contend that col. 4, lines 28-31 of Luchs teaches: "the information included in the original application is electronically stored", which is not what claims 1, 7, and 13 require. Luchs teaches storing "information included in the original application". In contrast, claim 1 requires storing the **contract** and said **tracking data**. In fact, Luchs does not even disclose tracking data, as admitted by the Examiner. Thus, the Examiner's argument relating the preceding feature of claims 1, 7, and 13 in the third example is not persuasive.

As a fourth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Applicants respectfully maintain that the Examiner's argument for modifying Luch's invention with Hoyt (for approvals) and Shirley (for key date reminders) is not persuasive. The Examiner argues: "It would have been obvious to

one of ordinary skill in the art at the time of the invention to modify Luchs' invention to include means for tracking the approval status and important dates associated with a contract. Such a modification would have given an agent generating a contract more flexibility. Allowing a client to fill in clauses appropriate for the client and further allowing the agent to track the document's status and associated dates would have alleviated a communication burden if negotiating was necessary."

In response, Applicants observe the following teaching in col. 2, lines 14-18 of Shirley: "The present invention also provides auxiliary documents which are related to the negotiated contract documents such as payment schedules, due date schedules, termination dates, and other tasks which accompany the execution of a contract". A review of the preceding dates disclosed in Shirley reveals that said dates disclosed in Shirley relate essentially to events which will occur after the contract has been generated and not to events that support the contract generation process. However, Luch's invention is concerned essentially with the contract generating process and not with events occurring after the contract has been generated. Therefore, Shirley's dates are not relevant to Luch's invention. Accordingly, it would not be obvious to a person of ordinary skill in the art to modify Luch's invention by adding Shirley's means for tracking dates.

Based on the preceding arguments, Applicants respectfully maintain that claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley , and that claim 1 is in condition for allowance. Since claims 2-6 depend from claim 1, Applicants contend that claims 2-6 are likewise in condition for allowance. Since claims 9-12 depend from claim 7, Applicants contend that claims 9-12 are likewise in condition for allowance. Since claims 14-21

depend from claim 13, Applicants contend that claims 14-21 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims 1-21 and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below.

Date: 06/13/2003

Jack P. Friedman
Registration No. 44,688

Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, New York 12110
(518) 220-1850